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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,815	09/25/2003	Paul Moulton	A35985 - 070121.0573	7621

21003 7590 05/13/2005

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NEW YORK, NY 10112

EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,815

Applicant(s)

PAUL MOULTON

Examiner

Yvonne M. Horton

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,10-15,17-21,23 and 24 is/are rejected.
- 7) ☒ Claim(s) 9,16,22 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/31/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>see attachment</u> . |

PW

DETAILED ACTION

Claim Objections

Regarding claims 6 and 20, the phrase "accordion-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "like"), thereby rendering the scope of the claim(s) unascertainable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,5-8,10 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #4,637,085 to HARTKORN. HARTKORN discloses the use of a compression seal including a compressible sealing portion (2) having an elastic membranes (T,48) and at least a lateral wing (5,6) extending therefrom and extruded as one-piece therewith; wherein the lateral wings clearly, as seen in the drawings, have a thickness larger than the elastic membranes (T,48). In reference to claim 2, HARTKORN discloses that his wings (5,) have a thickness of 3.5 cm that converts to 1.37 inches and is at least a half of an inch. Regarding claim 5, the compressible sealing portion includes longitudinal tubes (T) that extends along the length thereof. In reference to claim 6, the compressible sealing (2) portion in an elastic "accordion-like"

Art Unit: 3635

member. Regarding claims 7 and 8, the lateral wing portion (5,6) includes longitudinal channels (CH) and grooves (as at 40). In reference 10, the compressible seal of HARTKORN has the same cross-sectional configuration throughout.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #4,637,085 to HARTKORN in view of US Patent #5,213,441 to BEARVELDT. HARTKORN discloses the basic claimed compression seal except for explicitly detailing the type of rubber material used to form the seal. BEARVELDT teaches that it is known in the art to use EPDM rubber to form a compressible sealing member. Although BEARVELDT does not explicitly detail ethylene propylene tetrapolymers, as per the applicant's own disclosure and from what is known by one

Art Unit: 3635

having skill in the art, ethylene propylene tetrapolymers, in trade, is referred to as EPDM. Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the compression seal of HARTKORN out of the EPDM material of BAERVELDT in order to provide stability, carry a torque and to accommodate different lengths in joint sizes.

Claims 11-15, 19-21, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,584,152 BAERVELDT in view of 4,637,085 to HARTKORN. BAERVELDT discloses the use of an expansion system including an expansion joint (J) disposed between adjacent concrete elements (C) of a structure; a one-piece compression seal having a compressible sealing portion (11) having an elastic membranes (T) and at least a lateral wing (12) extending therefrom; and a block-out region (letter (e) column 4) such that the block-out region is adapted to receive the lateral wing (12) and is bonded thereto. BAERVELDT discloses the basic claimed expansion joint system except for the lateral wings having a thickness larger than the thickness of the elastic membranes. HARTKORN teaches that it is known in the art to form lateral wings (5,6) of a compression seal (1) such that the thickness of the lateral wings (5,6) is larger than the thickness of the elastic membranes (T, 48). Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the compression seal of BAERVELDT with lateral wings having a larger thickness than the elastic membranes, as taught by HARTKORN in order to enhance the rigidity of the joint seal. Regarding claim 12, BAERVELDT discloses the use of a block-out region (as at 15) that has a thickness slightly greater than the lateral.

Art Unit: 3635

wing thickness (12). In reference to claim 13, HARTKORN teaches that his wings (5,) have a thickness of 3.5 cm that converts to 1.37 inches and is at least a half of an inch. In reference to claims 14 and , BAERVELDT discloses that his lateral wings (12) are bonded by adhesives and is bolted as at (B) to the block-out regions (column 4, letter (h)). Regarding claim 19, the compressible sealing portion includes longitudinal tubes (T) that extends along the length thereof. In reference to claim 20, the compressible sealing (11) portion in an elastic "accordion-like" member. Regarding claims 21, the lateral wing portion (5,6) includes longitudinal channels (CH). In reference 23, the compressible seal of BAERVELDT has the same cross-sectional configuration throughout. In reference to claim 25, the concrete elements (C) include a floor (CF), and a vertical wall (VW) wherein the compressible sealing portion (11) includes vertical side walls (VS) that are bonded to the vertical walls (VW) of the concrete floor (CF).

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,584,152 to BAERVELDT in view of 4,637,085 to HARTKORN, as applied to claim 11 above, and further in view of US Patent #5,213,441 to BAERVELDT. BAERVELDT '152 discloses the basic claimed compression seal except for explicitly detailing the his rubber material used to form the seal is EPDM. BEARVELDT '441 teaches that it is known in the art to use EPDM rubber to form a compressible sealing member. Although BEARVELDT '441 does not explicitly detail ethylene propylene tetrapolymers, as per the applicant's own disclosure and from what is known by one having skill in the art, ethylene propylene tetrapolymers, in trade, is referred to as EPDM. Hence, it would have been obvious to one having ordinary skill in the art at the

Art Unit: 3635

time the invention was made to form the compression seal of BAERVELDT '152, as modified by HARTKORN, out of the EPDM material of BEARVELDT '441 in order to provide stability, carry a torque and to accommodate different lengths in joint sizes.

Allowable Subject Matter

Claims 9,16,22 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

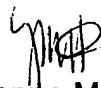
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yvonne M. Horton
Art Unit 3635
5/11/05

4,637,085

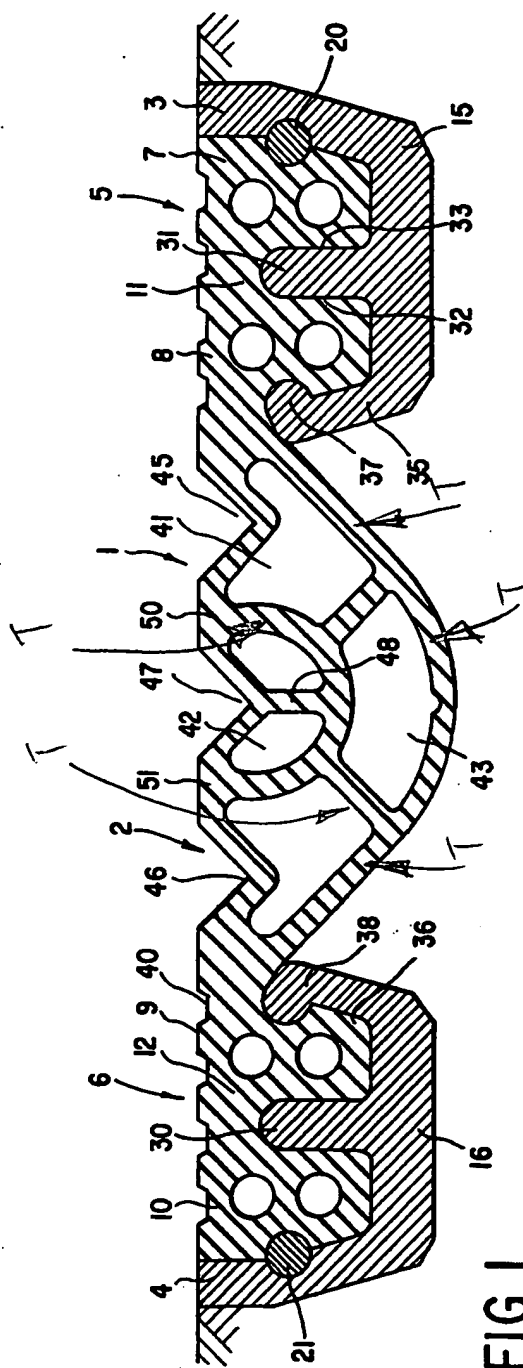


FIG. 1

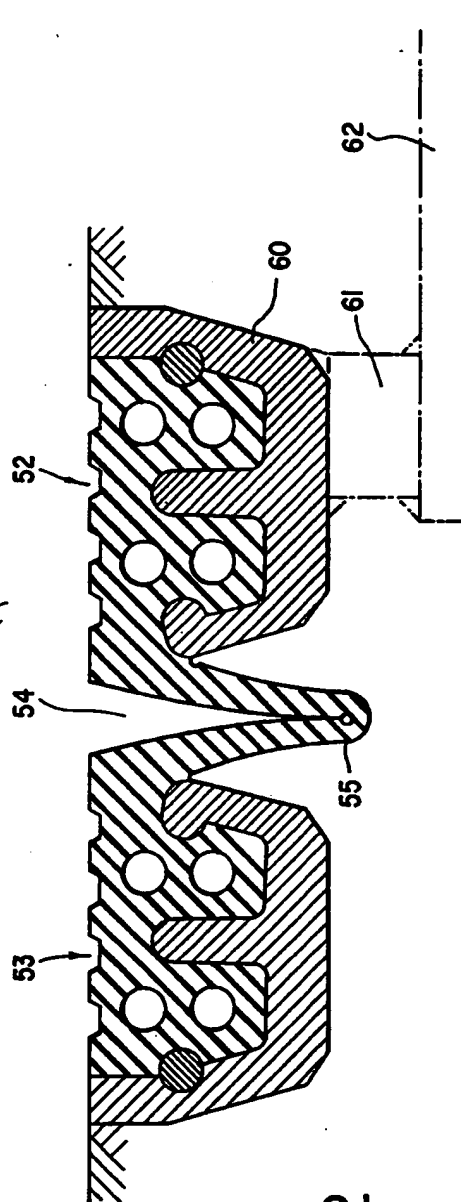


FIG. 2

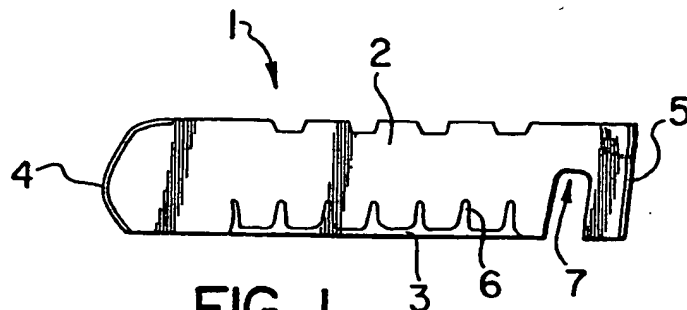


FIG. 1

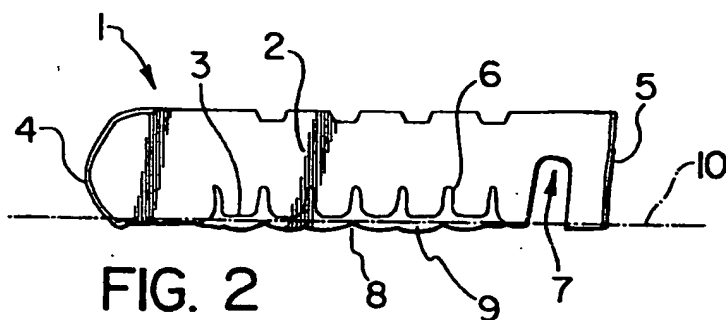


FIG. 2

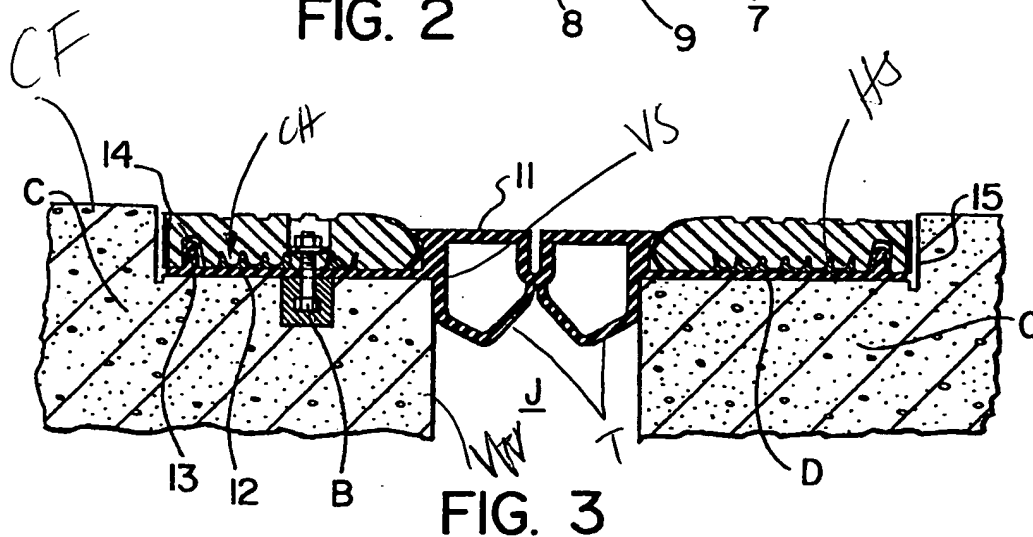


FIG. 3

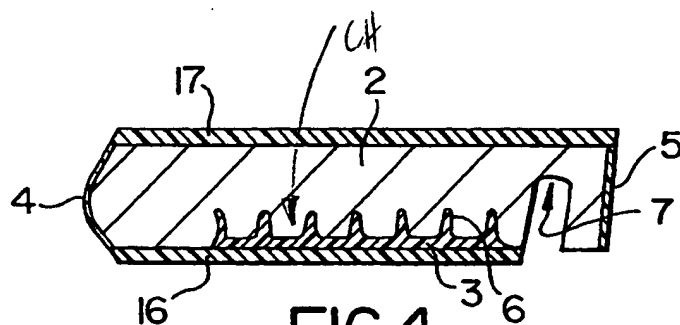


FIG. 4